

REMARKS

Claim Rejections - 35 USC 103

Claims 1 – 3, 15, 17 – 21, 55 – 75, and 78 – 85 are rejected under 35 USC 103 as being unpatentable over US patent number 5,933,498 and further in view of US patent number 5,465,299.

The Examiner asserts the '498 patent, for example, as teaching the delivering and calculating steps set forth in Applicant's Claim 1. However, a close examination of the '498 patent shows that there is no notion of a security server used to prevent the user from performing a standard operation found anywhere in this document. In each embodiment of the invention set forth in the '498 patent an access mechanism is shown associated with the user's computer. In Figure 2, the packaged data which is sent to the user is shown as comprising an encrypted body part, an unencrypted body part, encrypted rules, and encrypted ancillary information. The packaged data is processed at the user computer by the access mechanism. See, also, column 17, lines 35 – 52.

Accordingly, the '498 patent applies rules to packaged data at the client device, while the claimed invention is concerned with using a "security server to prevent the user from performing a standard operation on said version, said standard operation consisting of any of copying, printing, or saving." Applicant unambiguously claims a method in which the document server delivers all versions of the document to the user, while the '498 patent teaches the delivery of a package to the user that is operated upon by an access mechanism to determine what access the user may have to the packaged information. The delivery of a single package to a user is not instructive to the skilled person in creating a system in which multiple versions of the actual contents of a specific document are delivered by a document server to a user upon payment of various calculated charges. As such, the '498 fails to teach or suggest a server-side control mechanism. Rather, the teaching therein is solely concerned with a client-side

mechanism. The teaching of one is not instructive in connection with teaching the other. Thus, the '498 patent fails to teach that which it is asserted to teach.

Further, the claimed invention calculates charges based upon user selection of portions of a document and based upon the performance of a standard operation on those selected portions of the document. No such mechanism is shown in the '498 patent. The access control qualities set forth in the '498 patent (column 25, lines 6-48) do not suggest the selection of a portion of a document from a first version of that document which is delivered to a user by a document server and the performance of a standard operation upon another version of the document that is delivered to the user by the document server on a second cost basis. Thus, this aspect of the claimed invention is missing from the cited reference.

The Examiner has also referred to the '299 patent as teaching, for example the delivering step of Applicant's Claim 1. However, the '299 patent is a versioning system. That is, the '299 patent is not concerned with delivering "a second version of the actual contents of said specific document residing at a document server comprising said user-selected portion of said specific document, wherein a user requests a standard operation is completed in coordination with a document server upon payment of the calculated charge." No such mechanism is contemplated in the '299 patent. Rather, the '299 patent provides that any addition of data or changing of data within a document creates a new version of the document. A digital signature system is used to maintain version control. See, for example, column 2, line 59 through column 4, line 49.

To establish a *prima facie* showing of obviousness under 35 USC 103, the Examiner must present prior art teachings that show each and every element of the claimed invention. Here, there is no showing of the use of a document server to control the performance of standard operations on a document by a user on different cost bases, nor is there any showing of a system in which versions of an actual document may be provided by the document server. In this regard, it is important not to conflate the use of the term "version" in Applicant's claim with that in the '299 patent. In the latter case,

changes to a document are tracked and documented in a secure manner. In the claimed invention, a transaction may be entered into by which a document server provides a further version of the actual contents of a specific document on which the user may perform a standard operation. Tracking changes to a document (as in the '299 patent) is not in any way similar to providing different forms of the document (as claimed). The term "version" has a different meaning in each case.

Further, it is necessary to look at Applicant's claim in its entirety and not perform a piecemeal, hindsight dissection of the claim. Applicant's claim requires a document server. The document server is capable of providing a first user-viewable version and a second version of the actual contents of a specific document. Thus, Applicant's document server performs multiple functions. The Examiner's analysis uses one teaching (the '498 patent) for one function of this server and another teaching (the '299 patent) to show the other function of the server. Even if those patents taught both the claimed server function and the claimed version-delivery function (which they do not), the Examiner has not shown any teaching of the claimed server which performs both of those claimed functions in combination. In addition to those two functions, Applicant's claim also provides a mechanism for calculating a charge that permits the user to perform a requested standard operation on a user-selected portion of the specific document. Thus, to find a prior art teaching of the invention, it would be necessary to find a single teaching in which a document server is provided that serves both versions of the document in the form set forth in Applicant's claim, *i.e.*, on at least two different costs bases, one of which includes the user's ability to perform standard operations on a selected portion of the document that are not permitted on the other version thereof.

In the Examiner's analysis, the '498 patent is relied upon to show a first server for distributing a document and the '299 patent is relied upon to show a second distribution by a server. However, neither reference shows a single server performing both operations as claimed by Applicant. Thus, it would be necessary for the skilled person, having reference to the cited documents, to "invent" a way to combine both documents' teachings to produce the claimed invention. Even doing so, the skilled person would not

arrive at the claimed invention because there is no mechanism for using a document server to control the user's ability to perform a standard operation in connection with a specific document based on a cost basis. The client-centric mechanism of the '498 patent does not teach this, nor does the version management system of the '299 teach this. As such, Applicant respectfully submits that the Examiner has failed to make a *prima facie* showing of obviousness.

Applicant submits herewith a new Claim 86 which is drawn to a feature of the invention by which "access to any and all versions of said specific document is restricted by said document server on a per use and for action basis." Support for this new claim is found at least on page 7, lines 7 – 13 of the application as filed.

Should The Examiner deem it helpful, she is encouraged to contact Applicant's attorney, Michael A. Glenn, at (650) 474-8400.

Respectfully Submitted,



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